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| 09/817,998 | 03/27/2001 | Ronald P. Sansone | E-984 | 2015 |

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| EXAMINER |
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BORISSOV, IGOR N

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| ART UNIT | PAPER NUMBER |
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3639

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/817,998
Filing Date: March 27, 2001
Appellant(s): SANSONE, RONALD P.

Charles R. Malandra, Jr.
For Appellant

EXAMINER'S ANSWER

RECEIVED

APR 21 2005

GROUP 3600

This is in response to the appeal brief filed 2/02/2005

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-12 and 15-27 are stand and fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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| | | |
|-----------------|-----------------|------------|
| US 2002/0165729 | Kuebert et al. | 11/07/2002 |
| US 5,636,038 | Lynt et al. | 06/03/1997 |
| US 6,072,862 | Srinivasan | 06/06/2000 |
| US 6,542,584 | Sherwood et al. | 04/01/2003 |
| US 4,037,956 | McKeen, Jr. | 07/26/1977 |
| US 6,289,323 | Gordon et al. | 09/11/2001 |
| US 6,390,921 | Busch et al. | 05/21/2002 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 15-16, 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al. (US 2002/0165729) in view of Lynt et al. (US 5,636,038) and further in view of Srinivasan (US 6,072,862).

Kuebert et al. teach a method and system for flexible mail delivery, comprising:

Independent Claim.

Claim 1. Depositing with the carrier mail containing the recipient's name and physical address and the sender's name and address [0039]; capturing the name and physical address of the recipient and the sender in the form of an image [0020]; [0031]-

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[0032]; translating the name and physical address of the recipient into a telephone number [0022]; [0029]; utilizing the telephone number of the recipient to inform the recipient of the availability of the deposited mail [0036]; [0038]; notifying the carrier of the manner in which the recipient would like the mail delivered [0043]; delivering mail to the recipient in the manner specified by the recipient to the carrier [0048]; [0050].

Kuebert et al. do not specifically teach that said informing the recipient of the availability of the deposited mail is utilized via a tactile communication device. Also, Kueber et al. do not teach charging the recipient for delivering mail to the recipient.

Lynt et al. teach a method and system for converting visual images and sounds into tactile representations for user by a visually impaired person, wherein a printed document is scanned to obtain an image of said document; and said image is processed to provide a Braille representation of said image on a Braille reader. Furthermore, said Braille reader can be connected to a telephone for providing tactile representations of speech received through the telephone (column 6, lines 15-27).

Srinivasan teaches a method and system for adaptable message delivery, wherein the term "subscriber" indicates charging the recipient for delivering mail to the recipient (column 2, lines 37-58).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kuebert et al. to include that said informing the recipient of the availability of the deposited mail is utilized via a tactile communication device, as disclosed in Lynt et al., because it would advantageously allow a visually and hearing impaired person to communicate with other persons, businesses or information channels, thereby obtaining information about the world around them that a hearing person would ascertain through hearing, as specifically stated in Lynt et al. (column 2, lines 56-59).

And it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Kuebert et al. in view of Lynt et al. to include charging the recipient for delivering mail to the recipient, as indicated in Srinivasan, because it would advantageously allow to generate funds for business to operate.

Dependent Claims.

Claims 2 and 9. Said method and system, wherein the recipient notifies the carrier to deliver the mail to a specified name and address (Kuebert et al.); [0009]; [0043].

Claim 3. Notifying the carrier by the recipient to deliver the mail to a specified name and address [0009]; [0043] (Kuebert et al.). Examiner broadly understands the phrase "specified name and address" as being any address, including the address of the sender.

Claims 4-8. Srinivasan teaches a method and system for adaptable message delivery, wherein the recipient can select the preferred way of getting the mail; said method includes informing the carrier to e-mail or send by facsimile the contents of the mail piece to one or more specified e-mail addresses (column 2, lines 37-58; column 3, lines 4 – column 4, line 7). The motivation to combine Kuebert et al. and Lynt et al. with Srinivasan would be to advantageously allow the recipient to access all his messages via one message accessing means regardless the form said messages were sent to, as specifically stated in Srinivasan (column 4, lines 56-65).

Claims 10 and 16. Said method and system, wherein the recipient notifies the carrier to hold the mail for a specified period of time [0043] (Kuebert et al.).

Claim 11. Notifying the carrier by the recipient to change the delivery time [0043] (Kuebert et al.). Examiner broadly understands the phrase "change the delivery time" as choosing any possible date, including the date which is prior the date that paid for by the sender.

Claim 15. Said method and system, further including the step of: informing the sender of the delivery of the mail [0042] (Kuebert et al.).

Claims 19-21 and 23-25. Said method and system, wherein the recipient is notified via e-mail, a telephone or facsimile [0036] (Kuebert et al.).

Claim 26. Srinivasan teaches said method and system, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered (column 2, lines 37-58; column 3, lines 4 – column 4, line 7). The motivation to combine Kuebert et al. and Lynt et al. with Srinivasan would be to

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advantageously allow the recipient to manage the delivery of all his messages via one message accessing means regardless the form said messages were sent to.

Claim 27. Lynt et al. teach said method and system, wherein the recipient is visually impaired (column 6, lines 15-27). The motivation to combine Kuebert et al. with Lynt et al. would be to advantageously allow a visually and hearing impaired person to communicate with other persons or businesses.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of Sherwood et al. (US 6,542,584).

Claim 12 and 14. Kuebert et al., Lynt et al. and Srinivasan teach all the limitations of **claim 12**, except charging the recipient for receiving notification of the availability of the deposited mail.

Sherwood et al. teach a method and system for automatic voice mail redirection, wherein a recipient is charged a fee for receiving a notification that a voice mail message is left for the recipient (column 1, lines 10-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include charging the recipient for receiving notification of the availability of the deposited mail as disclosed in Sherwood, because it would generate funds for a business to operate.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of McKeen, Jr. (US 4,037,956).

Claim 17. Kuebert et al., Lynt et al. and Srinivasan teach all the limitations of **claim 17**, except that the recipient notifies the carrier to destroy the mail.

McKeen, Jr. teaches a method and apparatus for verified mail system, wherein the verified content of the recipient mail is destroyed if the recipient does not want to keep it stored (column 2, lines 28-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include that the recipient notifies the carrier to destroy the mail as disclosed in McKeen, Jr., because it would advantageously decrease the expenses for handling mail for the post office.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of Gordon et al. (US 6,289,323).

Claim 18. Kuebert et al., Lynt et al. and Srinivasan teach all the limitations of **claim 18**, including sending the contents of the mail piece to one or more specified e-mail addresses, except that the recipient notifies the carrier to recycle the material comprising the mail.

Gordon et al. teach a method and system for a mail delivery including sending the contents of the mail piece to one or more specified e-mail addresses, wherein the mail piece (a postcard) is recycled (column 15, lines 63-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include that the recipient notifies the carrier to recycle the material comprising the mail as disclosed in Gordon, because it would advantageously decrease the expenses for handling mail for the post office, and allow to save natural resources.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuebert et al., Lynt et al. and Srinivasan in view of Busch et al. (US 6,390,921).

Claim 22. Kuebert et al., Lynt et al. and Srinivasan teach that the recipient is notified via e-mail and a website of the availability of the deposited mail [0036]; [0043] (Kuebert et al.).

However, Kuebert et al., Lynt et al. and Srinivasan do not specifically teach that the recipient is notified via television of the availability of the deposited mail.

Busch et al. teach a method and system for sharing information in a network environment, wherein a user can receive a message via e-mail, or Web-TV, or telephone, or regular mail delivery (column 4, lines 38-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuebert et al., Lynt et al. and Srinivasan to include that the recipient is notified via television as disclosed in Busch et al., because it would advantageously allow to combine the notification service with other TV or WEB related programs, thereby make it more attractive to the customers.

(11) Response to Argument

Argument A.

Claims 1-11, 15-16, 19-21 and 23-25

11.1 Applicant argues that the cited patents do not disclose or anticipate the step of charging the recipient for delivering mail to the recipient in the manner specified by the recipient.

In response to this argument the Examiner points out that Kuebert et al. teach said method and system for flexible mail delivery, wherein a recipient specifies how mail should be delivered. Specifically, Kuebert et al. teach: "the recipient communicates instructions ..., recipient's instruction include a new delivery point (e.g., "deliver to my office instead of my home"), a new delivery time (e.g., "deliver today at 7:00 p.m."), and other information, such as special delivery instructions (e.g. "place inside garage," or "hold item for one week, I will pick up at Post Office on that date")." [0043].

As per "charging the recipient", Srinivasan was applied for this feature.

Specifically, Srinivasan teaches said method and system for adaptable message

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delivery, wherein the term “subscriber” indicates charging the recipient for delivering mail to the recipient (column 2, lines 37-58). Merriam-Webster’s Collegiate Dictionary defines the term subscription as: “an arrangement for providing, receiving, or making use of something of a continuing or periodic nature on a *prepayment plan*” (10th ed., Page 1173).

11.2 Applicant argues that the cited patents also do not disclose or anticipate the step of utilizing the telephone number of the recipient and the translated “image alphanumerics” to inform the recipient of the expected delivery of the deposited mail via a tactile communication device; and that the cited patents do not teach converting an address field into a telephone number.

In response to this argument the Examiner points out that Kuebert et al. teach that mail items are scanned by a camera (120) (Fig. 1) to obtain an image of the mailing label, which is then translated by a pattern recognition device (125) to create a database entry including a recipient’s name, delivery point and notification channels for communicating with the recipient, such as a recipient’s telephone number [0022]; and utilizing the telephone number of the recipient to inform the recipient of the availability of the deposited mail [0036].

As per “informing the recipient via a tactile communication device”, Lynt et al, was applied for this feature. Specifically, Lynt et al. teach a method and system for converting sounds and visual images into tactile representations for a user by a visually impaired person, wherein a Braille reader is connected to a telephone for providing tactile representations of speech received through the telephone. Furthermore, Lynt et

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al. teaches scanning a printed document to obtain an image of said document; and processing said image to provide a Braille representation of said image on a Braille reader (column 6, lines 15-27).

11.3 In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kuebert et al., Lynt et al. and Srinivasan relate to delivering information to a customer. The motivation to combine Kuebert et al. with Lynt et al. to include utilization of a tactile communication device for communication with a customer would be to advantageously allow a visually or hearing impaired person to communicate with other persons, businesses or information channels, thereby obtaining information about the world around them that a hearing or sighted person would ascertain through hearing or vision, as specifically stated in Lynt et al. (column 1, lines 43-46; column 2, lines 56-59). And the motivation to combine Kuebert et al. and Lynt et al. with Srinivasan to include charging the customer for delivering mail to the customer would be to advantageously allow to generate funds for the business to operate.

Argument B.

Claim 12

In response to applicant's argument that the art cited by the Examiner does not disclose or anticipate a method in which a recipient is charged for receiving notification of the availability of deposited mail, the Examiner points out that Kuebert et al., Lynt et al. and Srinivasan teach said method and system for flexible mail delivery, wherein a subscriber receives notification of the availability of the deposited mail (Kuebert et al. [0036]; [0038]), wherein the term "subscriber" indicates charging the recipient for the service (Srinivasan, column 2, lines 37-58, and a discussion above). As per "charging the recipient for receiving notification", Sherwood et al. was applied for this feature. Specifically, Sherwood et al. teach said method and system for automatic voice mail redirection, wherein a recipient is charged a fee for receiving a notification of availability of a voice mail message left for the recipient (column 1, lines 10-24).

Argument C.

Claim 17

In response to applicant's argument that the art cited by the Examiner does not disclose or anticipate a method in which the recipient notifies the carrier to destroy the mail, the Examiner points out that Kuebert et al. teach said method and system for flexible mail delivery, wherein the recipient communicates instructions to the carrier regarding handling the mail [0043]. As per "notifying the carrier to destroy the

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mail", McKeen, Jr. was applied for this feature. Specifically, McKeen, Jr. teaches said method and apparatus for verified mail system, wherein the verified content of the recipient mail is destroyed if the recipient does not want to keep it stored (column 2, lines 28-35).

Argument D.

Claim 18

In response to applicant's argument that the art cited by the Examiner does not disclose or anticipate the recipient notifying the carrier to recycle the material comprising the mail, the Examiner points out that Kuebert et al. teach said method and system for flexible mail delivery, wherein the recipient communicates instructions to the carrier regarding handling the mail [0043]. As per "notifying the carrier to recycle the material", Gordon et al. was applied for this feature. Specifically, Gordon et al. teach said method and system for a mail delivery including recycling a postcard after the contents of the postcard was distributed to the recipient via e-mail (column 15, lines 63-65).

Argument E.

Claim 22

In response to applicant's argument that the art cited by the Examiner does not disclose or anticipate notifying a recipient of mail via television of the availability of the

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deposited mail, the Examiner points out that Kuebert et al. teach said method and system for flexible mail delivery, including notifying a recipient of the availability of the deposited mail [0036]; [0038]. As per "notifying a recipient via television", Busch et al. was applied for this feature. Specifically, Busch et al. teach said method and system for sharing information in a network environment, wherein a user receives a message via Web-TV or regular mail delivery (column 4, lines 38-44).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor Borissov

IB

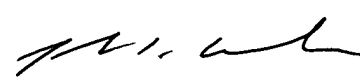
April 14, 2005

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